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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,823	11/04/2003	James O. Smith JR.	CDR-02-011	4446

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MCI, INC
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW, 10TH FLOOR
WASHINGTON, DC 20036

EXAMINER

CHAN, WING F

ART UNIT PAPER NUMBER

2643

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,823

Applicant(s)

SMITH ET AL.

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 10, 14-14, 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Steel, Jr. (US PUB. NO. 2004/0111268 with an effective filing date of Nov. 6, 2002, hereinafter Steel).

As to claims 1, 10, 21, Steel discloses a system and method for providing communication as claimed; see Fig. 5, paragraphs 0023 to 0047 for example. Steel teaches receiving a call request from a hearing-impaired party for establishing a call with a hearing party (e.g. [0032]-[0033], identifying a communication assistant (e.g. [0026, 0035, 0036]), forwarding the call to the communication assistant (e.g. [0027, 0028, 0039]), establishing a link to the hearing-impaired party by the communication assistant (e.g. [0040, 0041, 0047]), establishing a link to the hearing party by the communication assistant (e.g. [0042, 0044]), generating instant (text) messages (e.g. [0047, 0062]), transmitting the instant messages to the hearing-impaired party.

As to claims 2, 14, 15, 22, 23, see Steel [0044] for example.

As to claims 3, 16, see Steel [0006, 0023] for example.

As to claims 4, 17, see Steel [0006, 0023, 0049] for example.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel.

Steel although discloses providing the hearing-impaired party with a user interface window (interface screen), e.g. [0047, 0054], such that the hearing-impaired party is able to communicate information, i.e. called telephone number, text of conversation, with the communication assistant. Steel differs from the claimed invention in not disclosing transmitting an interface screen to the hearing-impaired party in response to the request. As is conventional in the art, a communication assistant

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requests the called party telephone number from the hearing-impaired party, e.g. see Steel [0021], therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel's instant messaging relay system to transmit an interface screen to the hearing-impaired party to request for the called telephone number in order to establish the call connection.

6. Claims 6, 7, 12, 13, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel as applied to claims 5 above, and further in view of Kay et al (US PAT. NO. 6,430,602 filed Aug. 22, 2000 hereinafter Kay).

As to claims 6, 12, 27-32, Steel differs from the claimed invention in not disclosing the interface screen further includes a second area for allowing the hearing-impaired party to select an instant messaging program to communicate with the communication assistant. However, it is old and well known in the art that there is various different instant messaging programs such as AOL Instant Messenger, Microsoft's Network Messenger services, or YAHOO, for example see Kay col. 1 lines 43-58. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to include in the interface screen a second area for allowing the hearing-impaired party to select the correct instant messaging program to communicate with the communication assistant, i.e. to select the instant messaging program by AOL or Microsoft that's currently in the hearing-impaired party's computer, to ensure compatibility.

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As to claims 7, 13, see Kay col. 5 lines 11+ which discloses the use of an e-mail address (john@aol) for identifying the instant message user.

7. Claims 8, 9, 18-20, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel in view of Hamilton (US PAT. NO. 6,801,613 filed Aug. 31, 2000).

As to claims 8, 18, 25, Steel differs from the claimed invention in not disclosing the voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link. However, it is old and well known in the art to use voice over Internet Protocol link in ACD systems as an alternative since VOIP link provides cost and bandwidth advantages over traditional PSTN and VOIP also provides both data and voice over the same network, for example see Hamilton col. 20 lines 36-58. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel's voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link to provide cost and bandwidth advantages over traditional PSTN.

As to claims 9, 19, 26, the call between the hearing-impaired party, communication assistant and hearing party is a conference call.

As to claim 20, the examiner takes Official notice that TDD relay services comprises voice carry over environment and speech-to-speech environment when a communication assistant communicates with the hearing party, and when a hearing but

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speech impaired person is involve, the relay call is in a "HCO" or "hearing carry over" relay call environment.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steel in view of Duffin (US PAT. NO. 5,991,723).

Steel differs from the claimed invention in not disclosing the processor automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties.

However, it is old and well known in the art to provide a processor that automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties to overcome the disadvantages such as limited number of operators (communication assistants), operators being under utilized, added expense, lacks privacy, etc., for example see Duffin Figs. 1-2, abstract, col. 1 lines 5-63, col. 4 lines 50-60. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to comprise a processor that automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties to overcome the disadvantages such as limited number of operators (communication assistants), operators being under utilized, added expense, lacks privacy, etc.

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Furthermore, it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carey et al (US PAT. NO. 6,714,793) discloses a method and system for instant messaging across cellular networks and public data network.

Morton (US PAT. NO. 6,480,484) discloses an internet-intranet greeting service.

Bossi et al (US PAT. NO. 6,421,425) discloses an automated communications assistant for the sound-impaired.

Sollee et al (US PAT. NO. 6,757,732) discloses text-based communications over a data network.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is 703-305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.



WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC
12/1/04